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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,428	01/06/2004	Lynn Patterson	DY-03	3799

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EXAMINER

LEE, CHRISTOPHER E

ART UNIT PAPER NUMBER

2112

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/752,428	Applicant(s) PATTERSON ET AL.	
	Examiner Christopher E. Lee	Art Unit 2112	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-14.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Christopher E. Lee
Patent Examiner
Art Unit: 2112

Continuation of 3. NOTE: The proposed amendment raises a new issue "a switch connected to a network and a bridge that is connected between the switch and the circuit card bus" in the claim 2, which has not been considered, and which extends the scope of the claimed invention. Therefore, it requires further consideration and/or search, and will not be entered.

Continuation of 11. does NOT place the application in condition for allowance because:

In response to the Applicants' argument with respect to "... Chan's bridge in Figure 4 and the orientation of backplane connections in Chan Figure 1 fail to teach or suggest 'a data bus connector for connecting the PCI-based mezzanine card (PMC) to a data bus of a circuit card,' and 'a bridge, connected between the switch and the data bus connector,' as recited in claim 1." in the Response page 9, line 1 through page 10, line 7, the Examiner believes that the Applicants misinterpret the claim rejection.

Essentially, the Applicants argue that PCI bus connection 402 (i.e., data bus connector) in Chan is not connected to Crossbar switch 408 (i.e., switch) through a Bridge 410 (i.e., bridge) in Fig. 4, unlike being recited in claim 1, i.e., "a data bus connector for connecting the PCI-based mezzanine card (PMC) to a data bus of a circuit card," and "a bridge, connected between the switch and the data bus connector." However, in contrary to the Applicants' allegation, the Examiner clearly points out that the claimed subject matter "data bus connector" is anticipated by Chan's "PCI CPU bus connection 402 and PCI main bus connection 404 in Fig. 4" (See Final Office Action on page 4, lines 18-19), and thus, said PCI main bus connection (i.e., data bus connector) is connected to said Crossbar switch (i.e., switch) through said Bridge (i.e., bridge), as recited in claim 1 (See paragraph 7 of the Final Office Action, claims 1-3, 5-7, and 9-11 rejection under 35 U.S.C. 102(e) as being anticipated by Chan). In fact, the claimed subject matter "data bus connector" is never limited to the connection to a host data bus, for example.

Thus, the Applicants' argument on this point is not persuasive.

In response to the Applicants' argument with respect to "The bridge of the claimed invention uses a data bus to connect the switch to a circuit card that is located on the PCI-based mezzanine card (PMC), not to a remote circuit card located on a different bus as is the case in the HSM 104/400 of Chan connecting the switch 408 to bus 106 to a data bus 106 off of the HSM. The claim 1 recites that the PCM card comprises the data bus (on the PCM) to a circuit card that would also reside on the PCM. ... The claimed PCM card has only one bus and that on-board bus is connected to a switch via a bridge. ..." in the Response page 10, line 8 through page 11, line 8, it is noted that the features upon which applicants rely (i.e., (i) a data bus to connect the switch to a circuit card that is located on the PCI-based mezzanine card (PMC), (ii) the PCM card comprises the data bus (on the PCM) to a circuit card that would also reside on the PCM, and (iii) PCM card has only one bus and that on-board bus is connected to a switch via a bridge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, the Applicants' argument on this point is not persuasive.

In response to the Applicants' argument with respect to "The rejections to claims 2 and 6 over Chan fail for the same reasons. The Examiner has alleged that Chan's architecture for the HSM bridge 410 that is connected between the switch and PCI main bus connection 404 of Figure 4 anticipate the claimed invention. This is incorrect further regarding claim 2 because that claim states that the PCM card is connected to the circuit card and to the bus for access to the processor of the circuit card via the bridge that is connected between the switch and the circuit card bus. Chan fails to teach or suggest this aspect because HSM bridge 410 is connected to PCI bus 404, not to the SBC 210, 212 via PCI bus 402." in the Response page 11, line 9 through page 12, line 1, the Examiner believes that the Applicants misinterpret the claim rejection.

In contrary to the Applicants' assertion, the Applicants recite the limitation "the PMC card is connected to the circuit card and to the bus for access to the processor of the circuit card, and the PMC card comprising a switch connected to a network and a bridge that is connected between the switch and the circuit card bus" in lines 5-8 of the claim 2. However, the claimed subject matter "the circuit card bus" has not been clarified in the claim 2, and thus, Chan clearly anticipates the limitation, such as the PMC card (PMC; i.e., Hybrid Switching Module 400 in Fig. 4) is connected to the circuit card (e.g., HSM A 104 coupled to System Host SBC A 102 in Fig. 1) and to the bus (i.e., said HSM 400 connected to PCI CPU bus connection 402 in Fig. 4) for access to the processor of the circuit card (See Chan, col. 5, lines 46-48), and the PMC card (i.e., said Hybrid Switching Module) comprising a switch (i.e., Crossbar Switch & Arbiter 408 of Fig. 4) connected to a network (i.e., I/O Links 112 in Fig. 1; See col. 5, lines 52-55) and a bridge (i.e., Bridge 410 of Fig. 4) that is connected between the switch (i.e., said Crossbar Switch & Arbiter) and a circuit card bus (i.e., PCI main bus connection 404 of Fig. 4; See col. 5, lines 41-45). For the sake of the argument, if the Applicants assert the claimed subject matter "the circuit card bus" is the same that the claimed subject matter "a bus" in the claim 2, the proposed amendment raises new issue.

Thus, the scope of the claimed invention has been extended, and the proposed amendment would require further consideration and/or search.

Furthermore, it is noted that the features upon which applicants rely (i.e., each PCM bridge can bridge data transfer from each processor (on a circuit card) between each circuit card's bus and each PMC switch) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, the Applicants' argument on this point is not persuasive.

In response to the Applicants' argument with respect to the rejection to Ravinovitz and the rejection to Craddock in the Response page 12, line 1 through page 15, line 17, the Examiner respectfully disagrees.

In fact, all the rejections under 35 USC §103(a) in the prior Office Action established a prima facie case of obviousness meeting the three basic criteria of the MPEP 2143.03 (8th ed. 2001). See the Final Office Action mailed on 5th of May 2006.

Furthermore, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has clearly pointed out rationale for appropriate combination of the references.

Thus, the Applicants' argument on this point is not persuasive.